

REMARKS/ARGUMENTS

Applicants and Applicants' representative gratefully acknowledge the telephone interview conducted with Examiner Chang on November 18, 2003. Applicants appreciate the Examiner's input and helpful comments during the interview.

Reconsideration of the present application in view of the following amendments and/or remarks and the Declaration of Dr. Natarajan S. Ramesh under 37 C.F.R. § 1.132 as indicated below is respectfully requested. In an office action mailed September 8, 2003, claims 1-7, 9-16, 18-27, and 29-31 were rejected.

Status of the Claims

Please cancel claims 11, 12, 20, and 21.

Upon entry of the foregoing amendments, claims 1-7, 9, 10, 13-16, 18, 19, 22-27, and 29-31 will be pending in the application. Claims 1 and 3 have been amended; claims 11, 12, 20, and 21 have been cancelled. No new matter has been introduced.

Claim Amendments

Claim 1 has been amended to recite that the composite flooring material consists essentially of a polyolefin foam sheet, a first polyolefin film heat-laminated to a first surface of the foam sheet, and a second polyolefin film heat-laminated to a second surface of the foam sheet, wherein at least one edge of the second film extends beyond a corresponding edge of the foam sheet. Support for this amendment may be found in the specification as originally filed at, *inter alia*, page 5, lines 13-32 and page 7, lines 11-29.

Claim 3 has been amended to place the claim in Markush form.

Claims 11, 12, 20, and 21 have been cancelled as a result of the amendments made to claim 1.

No new matter has been added.

Rejections Under 35 U.S.C. §112, First Paragraph

Claims 13, 14, 29, and 30 have been rejected under 35 U.S.C. §112, first paragraph, because the Examiner asserts that “the Specification lacks a teaching as to how to prevent the known wrinkle problem typically associated with the heat shrinkage of an oriented film by heat lamination.” (Office Action at page 2, ¶5, citing Akao.) Applicants respectfully traverse the rejection.

The enablement requirement of § 112 is satisfied so long as a disclosure contains sufficient information that persons of ordinary skill in the art having the disclosure before them would be able to make and use the invention. *In re Wands*, 8 U.S.P.Q.2d 1400 (Fed. Cir.1988) (the legal standard for enablement under § 112 is whether one skilled in the art would be able to practice the invention without undue experimentation). Applicants respectfully submit that one of ordinary skill in the art, when performing a lamination process such as that described in the specification at page 11, lines 13-30, would recognize that wrinkling of a stretch oriented film can be readily eliminated by laminating the film to the foam at a temperature lower than the heat set temperature of the film. Accordingly, Applicants disagree that such lamination results in a “wrinkle problem.” Additionally, one of skill in the art would readily recognize that the speed and temperature of the process, in particular the speed and temperature of the hot roller, can be easily adjusted to ensure that the lamination temperature remains below the heat set temperature of the film used, thus eliminating both shrinkage and wrinkling of the film. Adjustments such as these are made routinely by persons of skill in the art.

In particular, the specification teaches that the heat supplied to the film sheets from the hot roller is sufficient to cause the films to bond to the foam, but is low enough to keep the films or foam from melting. (Specification at page 11, lines 27-29.) Persons familiar with heat lamination of oriented films will appreciate that the film may be heated to a temperature within about 15 or 20 °F of the heat set temperature of the film to eliminate shrinking of the film while still producing sufficient heat bonding. For all of the foregoing reasons, Applicants believe that persons knowledgeable in the field of heat laminating oriented films would be able to practice the claimed invention without undue difficulty or experimentation. Applicants enclose a Declaration of Dr. Natarajan S. Ramesh to support the preceding assertions.

Based upon the foregoing arguments and the Declaration of Dr. Ramesh, Applicants believe that claims 13, 14, 29, and 30 are fully enabled by the application specification. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of those claims under §112, first paragraph.

Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 1-7, 9-16, 18-27, and 29-31 have been rejected under §112, second paragraph, as allegedly being vague and indefinite. Claims 1 and 3 have been amended to incorporate the Examiner's suggested revisions, and claims 11, 12, 20 and 21 have been cancelled.

Accordingly, Applicants believe that the Examiner's rejection has been overcome and respectfully request withdrawal of the rejection of claims 1-7, 9-16, 18-27, and 29-31 under 35 U.S.C. §112, second paragraph.

Rejections Under 35 U.S.C. §103(a)

Claims 1-7, 9-12, 15-16, and 18-23 have been rejected under §103(a) as being allegedly unpatentable over Akao (US 4,469,741) in view of Foster (US 5,968,630).

Claim 1 has been amended to recite that the composite flooring material consists essentially of a polyolefin foam sheet, a first polyolefin film heat-laminated to a first surface of the foam sheet, and a second polyolefin film heat-laminated to a second surface of the foam sheet, wherein at least one edge of the second film extends beyond a corresponding edge of the foam sheet. As the Examiner noted in the Interview Summary dated November 18, 2003, "Akao discloses the invention as claimed with additional structure", in particular an adhesive layer between the film and foam layers. As reflected in amended claim 1, however, the first and second films of the present invention are heat-laminated to the foam, eliminating the use of an adhesive layer. As a result, the first and second films are adjacent to opposite sides of the foam layer.

A prima facie case of obviousness requires that "the prior art reference (or references when combined) must teach or suggest all the claim limitations." (MPEP §2143.) Because Akao, as modified by Foster, does not result in the composition of amended claim 1, the present invention is not rendered obvious under §103. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-7, 9-12, 15-16, and 18-23 under Akao in view of Foster.

Claims 1-7, 9-12, 15-16, and 18-23 have also been rejected under §103(a) as being allegedly unpatentable over Foster in view of Deibel (US 6,358,599). Applicants respectfully submit that all of the elements of claim 1 and the remaining dependent claims are not present when Foster is combined with Deibel because, as noted by the Examiner in the Interview

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Summary dated November 18, 2003, the Deibel reference "appears to be directed to facers of alkenyl aromatic polymers, instead of polyolefins." As such, Applicants believe that the claims of the present application are not rendered obvious by Foster in view of Deibel and request that the rejection of those claims be withdrawn.

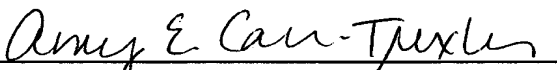
Conclusion

Applicants thank the Examiner for his helpful comments and suggestions during the telephone interview with Applicants' representative on November 18, 2003.

In light of the foregoing amendments and arguments and the enclosed Declaration of Dr. Natarajan S. Ramesh, Applicants believe that all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicants invite the Examiner to contact the undersigned at (215) 557-5966 to clarify any unresolved issues raised by this response.

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